

**REMARKS**

## **Request for Withdrawal of Final Rejection:**

The Applicant notes that the Examiner may withdraw the rejection of finally rejected claims if new facts or reasons are presented such as to convince the Examiner that the previously rejected claims are in fact allowable. (MPEP 706.07(e).) Accordingly, the Applicant hereby requests withdrawal of the final rejections of claims 21, 24, and 26-28, and 31 in view of the Applicant's arguments set forth below.

### Rejection of Claims Under 35 U.S.C. 103:

Claims 21, 24, 26-28, and 31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,731,455 to Kulakowski et al. ("Kulakowski") in view of U.S. Patent 5,329,412 to Stefansky.

Claims 21 and 26 are independent claims, claim 24 depends from claim 21, and claims 27, 28, and 31 depend from claim 26. Thus, if claim 21 is allowable, then claim 24 is allowable, and if claim 26 is allowable, then claims 27, 28, and 31 are allowable.

The Examiner contends that Kulakowski discloses a data storage library per claimed invention, including a storage library capable of handling tape cartridges or a combination of tape and hard disk drive devices (the Examiner cites column 11, lines 21-47 of Kulakowski).

The Examiner contends further that Kulakowski is silent as to the HDD having a form factor in the shape of a tape cartridge, and that Stefansky teaches a hard disk drive device housing having the dimensions of a tape cartridge (the Examiner cites column 1, lines 55-61 of Stefansky).

The Examiner also asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the housing dimension of Kulakowski, which coincides with the housing dimension of a magnetic tape cartridge, and that it would have been obvious for one of ordinary skill in the art to have provided the HDD of Kulakowski with a housing having the same dimension of a magnetic tape housing because such HDD cover had been known in the art, as demonstrated by Stefansky.

1       The Applicant argued previously, and continues to maintain, that the  
2 Examiner has not established a *prima facie* case of obviousness with respect to any  
3 of the claims at least because:

- 4       1) there is no suggestion or motivation, either in the references themselves or  
5           in the knowledge generally available to one of ordinary skill in the art, to  
6           modify the references or to combine the reference teachings;
- 7       2) there is no reasonable expectation for success; and,
- 8       3) the references do not teach or suggest all the claim limitations.

9       That is, the Applicant previously argued, and continues to maintain, that none of the  
10 above three requirements of a *prima facie* case of obviousness have been  
11 established for any of the Applicant's claims.

12       The Applicant argues that the lack of suggestion or motivation to combine the  
13 reference teachings, and the lack of reasonable expectation for success, are  
14 evidenced at least by the fact that Kulakowski teaches only a symmetrical, dual-  
15 ended cartridge (in which the data storage media can be accessed from two  
16 opposite ends), and by the fact that Stefansky teaches only an asymmetrical disk  
17 cartridge in which the cover "bulges outwardly" on one end, while it is "generally flat"  
18 on the other end. (Stefansky, col. 5, lines 40-44.).

19       That is, Kulakowski teaches a library system with a picker that is configured to  
20 be used only with dual-ended cartridges, wherein the cartridge is substantially  
21 symmetrical such that each end is essentially identical with the opposite end. In this  
22 manner, the dual-ended cartridge of Kulakowski can be gripped by the picker from  
23 either end. However, Stefansky discloses no more than an asymmetrical cartridge  
24 that has one rounded, or bulging, end and an opposite flat end, and which can only  
25 be accessed from one end or one side. The teachings of Kulakowski depend on the  
use of symmetrical, dual-ended cartridges, and therefore, Kulakowski teaches away  
from what is taught by Stefansky, which is the use of an asymmetrical, single-ended  
cartridge having one rounded, bulging end, and an opposite flat end.

26       Kulakowski reiterates in numerous locations a dual-ended cartridge:

27       In the described implementations, the storage device  
28 comprised a dual-end hard disk drive. In alternative  
29 implementations, the storage device may comprise any

1 storage device known in the art maintained in a housing that  
2 provides non-volatile storage of data that can be accessed  
3 from different locations or ends on the housing including the  
4 storage medium ... such as an electronic storage device,  
5 etc.” (Kulakowski, col. 11, line 63, through col. 12, line 6,  
emphasis added.)

[B]ecause the disk drives are dual-end, they can be swapped between pickers without the need to rotate the hard disk drive or interrupt the I/O flow. For instance, when swapping a dual-end hard disk drive between pickers, both pickers can be engaged with the data interfaces at opposite [ends] of the hard disk drive. This allows pickers to swap a hard disk drive and time the disengagement of one picker to minimize any interruption to data flow. Pickers on the same track may also swap hard disk drives to avoid collisions. Still further, the dual-end hard disk drives would not have to be rotated in either an Input/Output station or pass-through station between library modules because they may be engaged from either end. (Kulakowski, col. 11, lines 7-19.)

Therefore, in view of the fact that Stefansky teaches an asymmetrical cartridge that cannot be accessed from more than one side, while Kulakowski teaches a symmetrical, dual-ended cartridge and a library system of which the operation depends on the use of such dual-ended cartridges, it follows that there is no suggestion or motivation, nor is there any reasonable expectation for success, to combine the teachings of Kulakowski with the teachings of Stefansky, as is required for an obviousness rejection.

In regard to the Applicant's argument that the references do not teach or suggest all the claim limitations, the Applicant notes that the Examiner's rejection depends on the Examiner's contention that Stefansky discloses a hard disk drive device housed in a cover that has the dimensions of a tape cartridge.

1       The Applicant argues, however, that a cover that has the dimensions of a  
2 tape cartridge is not equivalent to a housing having a tape cartridge form factor  
3 suitable for use with a mechanical picker, nor is it equivalent to an exterior cartridge  
4 shell shaped to have a tape cartridge form factor, the cartridge shell adapted to be  
5 gripped and moved with a robotic gripper, as is claimed by the Applicant in claims 21  
and 26, respectively.

6       The words of a patent must be given their plain meaning (see MPEP 2111.01:  
7 Claim terms have ordinary and custom meaning per one of ordinary skill in the art.).  
8 In this regard, Webopedia ([www.webopedia.com](http://www.webopedia.com)) is an online dictionary dedicated to  
9 defining computer technology. Per Webopedia, the term “form factor” means: “The  
10 physical size and shape of a device.” Thus, the term “form factor” means both size  
11 and shape. Stefansky discloses a hard disk drive that has only one dimension (i.e.,  
12 the height) of a tape cartridge. (Stefansky, col. 1, lines 60-61.) Stefansky does not  
disclose a hard disk drive that has both the size and shape of a tape cartridge.

13      Further, the fact that a given cartridge has certain “dimensions” does not imply  
14 that the given cartridge is “suitable for use with a mechanical picker” or that the given  
15 cartridge is “adapted to be gripped and moved with a robotic gripper” as is claimed  
16 by the Applicant. In fact, Stefansky does not teach or suggest a cartridge suitable for  
17 use with any type of picker or gripper. Thus, Kulakowski and Stefansky do not teach  
or suggest all of the limitations of the Applicant’s claims, as is required for a *prima  
facie* case of obviousness.

18      Moreover, the Applicant maintains that the Examiner is misconstruing what  
19 Kulakowski discloses. The Examiner contends that Kulakowski discloses “a storage  
20 library capable of handling tape cartridges or a combination of tape and hard disk  
21 drive devices” (the Examiner cites column 11, lines 21-47 of Kulakowski). However,  
22 as is explained herein above with reference to the passage from Kulakowski (col. 11,  
23 line 63, through col. 12, line 2), Kulakowski suggests that tape cartridges cannot be  
24 used in a manner consistent with the recitations of the claims, which include *dual-*  
*ended* cartridges.

25      Furthermore, the passage of Kulakowski cited by the Examiner as disclosing  
the use of tape cartridges (col. 11, lines 21-47,) in fact does not disclose or suggest  
the use of tape cartridges. On the contrary, the cited passage only teaches that  
“[t]he preferred embodiments may be implemented as [an]...article of manufacture

[wherein] the term ‘article of manufacture’ as used herein refers to code or logic implemented in ... a computer readable medium (e.g. magnetic storage medium, hard disk drives, floppy disks, tape, etc.) ....” [Emphasis added.] Thus, the passage merely teaches that embodiments in Kulakowski can be in the form of programming code or logic for an operating system that is stored on tape. The cited passage does not teach or suggest in any way the use of tape cartridges for use with a library system.

In short, the cited references (Kulakowski and Stefansky) do not teach or suggest all of the claim limitations, as is required for an obviousness rejection. None of the requirements for a *prima facie* case of obviousness have been met with regard to each of the Applicant's claims. Accordingly, the Applicant respectfully requests that the final rejections of claims 24, 27, 28, and 31 be withdrawn and that those claims be allowed.

## SUMMARY

13 The Applicant believes that this communication constitutes a full and complete  
14 response to the final office action mailed 01/19/2005, and the Applicant furthermore  
15 requests timely allowance of claims 21, 24, 26-28, and 31. The Examiner is  
16 respectfully requested to contact the below-signed representative if the Examiner  
believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

**Stephen V. Deckers, Applicant**

By Thomas A. Oh

Thomas A. Olson

**Attorney and agent for Applicant**

Req. No. 44,271

Phone: (509) 327-4748

*Application S/N: 10/788,543  
Docket Number: 10004377-4  
Response to Final Action*